

REMARKS

Claims 74-78 and 91-94 are presently under examination. Claims 1-63 and 79-87 have been withdrawn. Claims 64-73, 88-90, and 93 have been cancelled. Claim 91 has been amended. The amendment to claim 91 does not add new matter. Support for the amendment may be found at paragraph [0137] of the published application.

I. §112, Second Paragraph Rejections

Reconsideration is requested of the rejection of claims 74-78, 91, 92, and 94 under 35 U.S.C. §112, second paragraph, for indefiniteness.

(a) Claim 76

Claim 76 is directed to a host cell comprising the expression vector of claim 74. Claim 76 is not a method claim.

The Office states that claim 76 is indefinite because it does not “clearly set forth method steps, there being an absence of a positive resolution or correlation step, which reads back on the preamble of the claimed methods.”¹ The Office is mistaken, however, because claim 76 is not a method claim. Consequently, the Applicants respectfully request withdrawal of the §112 second paragraph rejection to claim 76.

(b) Claims 74-78, 91, 92, and 94

Claim 91 is directed to a recombinant BTLA nucleic acid. The nucleic acid encodes a BTLA protein having at least about 98% identity to the amino acid sequence set forth in SEQ ID NO:8. The BTLA protein comprises an extracellular V-like Ig domain, a transmembrane region, and an intracellular domain, and is capable of inducible association with SHP-2 in T cells. Claims 74-78, 91, 92, and 94 incorporate the limitations of claim 91.

The Office states that claim 91 is indefinite because of the “recitation of ‘association.’”² The Office is mistaken however. The specification, in Example 7, paragraphs [0410]-[0412], teaches that “association,” in the context of this application,

¹ Office Action mailed 1/8/07, at point 6(A).

² Id. at point 6(B).

refers to co-immunoprecipitation. Additionally, Example 7 provides the methods for the co-immunoprecipitation experiments used, and therefore, one of skill in the art would be reasonably appraised that "association" encompasses co-immunoprecipitation in T cells.

Claims 74-78, 91, 92, and 94 incorporate the limitations of claim 91. Consequently, applicants respectfully request withdrawal of the rejection of claims 74-78, 91, 92, and 94 under §112 second paragraph.

II. §102(e) Rejection

Reconsideration is requested of the rejection of claims 74-78, 91, 92, and 94 under 35 U.S.C. §102(e) in light of US Patent No. 7,153,950 (the '950 patent).

As described previously, Claim 91 is directed to a recombinant BTLA nucleic acid encoding a BTLA protein having at least about 98% identity to the amino acid sequence set forth in SEQ ID NO:8.

According to the Office, the '950 patent discloses a polypeptide sequence which is 97.4% identical to SEQ ID NO:8.³

For a reference to anticipate a claim under 35 U.S.C. §102, the reference must teach "each and every" element as set forth in the claim" in a single prior art reference.⁴ Claim 91 requires a protein with 98% identity to the amino acid sequence of SEQ ID NO:8. As the Office has previously stated twice, the '950 patent discloses an amino acid with only 97.4% identity to SEQ ID NO:8.⁵ Additionally, the '950 patent only claims a sequence with 99% identity to their disclosed sequence. Therefore, contrary to the Office's assertion, the '950 patent does **not** disclose or claim SEQ ID NO:8. Because the '950 patent does not teach each and every element of claim 91, the '950 patent does not anticipate claim 91.

Additionally, claims 74-78, 92, and 94 include the limitations of claim 91. Therefore, the '950 patent does not anticipate claims 74-78, 92, and 94.

³ Office Action mailed 3/21/2006, at page 19; Office Action mailed 1/8/2007, at point 7.

⁴ *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); See Also MPEP §706.02.

⁵ Office Action mailed 3/21/2006, at page 19; Office Action mailed 1/8/2007, at point 7.

Moreover, claim 94 includes the additional limitation of the nucleotide sequence set forth in SEQ ID NO:7. The Office has stated that the '950 patent only discloses a nucleotide sequence with 98.2% identity to SEQ ID NO:7. In other words, as with SEQ ID NO:8, the '950 patent does not disclose the nucleotide sequence of SEQ ID NO:7, and therefore, the '950 patent does not anticipate claim 94 because the '950 patent does not teach each and every element of claim 94.

Consequently, Applicants' respectfully request withdrawal of the rejection of claims 74-78, 91, 92, and 94 under §102(e) in light of the '950 patent.

III.CONCLUSION

In light of the foregoing, applicants request entry of the claim amendments, withdrawal of the claim rejections, and solicit an allowance of the claims. The Examiner is invited to contact the undersigned agent should any issues remain unresolved.

Respectfully submitted,

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